

REMARKS/ARGUMENTS

The Examiner rejected Claims 25-27, 29, 30, 34-35 and 37-44 under 35 USC 103(a) as
5 being unpatentable over as being unpatentable over U.S. Patent Application to Kanojia et al.
(2004/0181593) in view of U.S. Patent to Grooters (6,931,593). Claims 36 and 44 as being un-
patentable over U.S. Patent Application to Kanojia et al. (2004/0181593) in view of U.S. Patent
to Grooters (6,931,593) and Chantini (US 2006/0129688). Applicant has amended Claims 25-27,
30, 34-39 and 41 to further clarify the invention and cancelled claims 28-29, 31-33 and 40.
10 Claims 25-27, 30, 34-39, 41-44 are now pending. Claims 25 and 37 are independent claims. Ap-
plicant respectfully requests reconsideration of the patentability of the pending claims of the pre-
sent application in view of the following remarks.

Office Action Response to Argument Submitted on October 5, 2006

On Page 6 of the Office Action, the Examiner addresses Applicants' comments made in
15 the Request for Continued Examination (RCE) of October 5, 2006. The following addresses the
Examiner's comments to the RCE of October 5, 2006:

The Office Action states that "Applicant's arguments with respect to claims 25-27 and
29-30 have been considered but are moot in view of the new ground(s) of rejection." Appli-
cant's respectfully disagree that the arguments set forth in the RCE of October 5, 2006 are moot
20 in view of the new grounds of rejection, as the rejection of the independent claims with regard to
the Kanojia reference has been maintained.

As stated in the RCE, Kanojia discloses a system that is different than the one used by the
present invention, as defined in Claim 25. Kanojia discloses a system where a server system 100
communicates with embedded client system 200 for generating an initial user profile for a net-

work device. (Kanojia, Paragraph 0099). Kanojia uses an elaborate registration process using management console 110 and web browser 210 that displays the registration web page wherein the user submits information which will be used to generate a user profile of user attributes associated with the network device. (Kanojia, Paragraph 0106 and 0107). Kanojia registers a network device and is associated with a user profile after the registration process. (Kanojia, Paragraph 0112).

Kanojia states in Paragraph 0114 that “[b]efore content can be deployed to a targeted device, the content **must** be stored in the database along with a group profile and an activation schedule”. The content delivery process/system of Kanojia is based on group profiles.

None of the foregoing are needed or used by the adaptive aspects of the present invention, as outlined in Claim 25. The process steps of Claim 25 do not require any group profiles or activation schedules.

Even in view of the new grounds for rejections, Applicant respectfully maintains its arguments stated above that the system of Kanojia is different than that of the present invention.

Rejections under 35 USC §103(a)

Claim 25 is rejected as being unpatentable over U.S. Patent Application to Kanojia et al. (2004/0181593) in view of U.S. Patent to Grooters (6,931,593). Kanojia and Grooters, in combination or by themselves fail to disclose a method for directed information delivery to a host system. The method includes “detecting attachment of a hardware device to a host system, wherein a client software running on the host system is notified of the hardware device attachment; querying the hardware device for device information, wherein the client software queries the hardware device; establishing a connection with a remote server system; forwarding to the server

system information related to the host system and the hardware device; wherein the host related information includes host operating system information and host system hardware information; and the hardware device information includes device class, device protocol, and vendor identification number to identify the hardware device; and said server system searches the world wide web for information related to the host system and the hardware device based on the host system information and the hardware device information provided to the server system; and a search result includes promotional or educational materials regarding the host system and the hardware device; identifying presentation data based on the search result; selecting most relevant data from among the presentation data, wherein the most relevant data is based on a user profile based on information collected by the client software; formatting the most relevant data for presentation to the user, wherein the formatting is based on a host system limitation and a host system requirement and a hardware device limitation and a hardware device requirement including graphic display capabilities of the host system and available bandwidth; and delivering to the host system formatted presentation data.

The Examiner cites that Kanojia fails to disclose, teach or suggest “querying the hardware device for device information, wherein the client software queries the device, the hardware device information includes device protocol, vendor identification number, the server system search the world wide web for information, and aggregates and formats presentation data based on the search for delivery to the host system.” (See page 3 of the Office Action)

The Office Action relies on Grooters to make up for these deficiencies in Kanojia et al. Specifically, the Office Action states that “Grooters teaches querying the hardware device for device information (upon determination . . . for additional information: col. 7, lines 37-39), wherein the client software queries the device (col. 7, lines 37-39), the hardware device informa-

tion includes device protocol, vendor information number (manufacturer, col. 5, line 53-56), the server system search the world wide web for information (Internet search; col. 7, lines 39-44 and col. 1-4), and aggregates and formats presentation data based on the search for delivery to the host system (col. 7, lines 44-46 and col. 8, lines)". Applicant respectfully disagrees.

5 Grooters provides an apparatus and method for automatically generating content channels associated with audiovisual media delivered on devices of a local network system. (Grooters, column 2, lines 1-6) Channels represent various devices in a home entertainment system or a home control system, and each device channel comprises further sub-channels ("or content channels") that provide additional information relating to content available via the device.
10 (Grooters, column 5, lines 48-53) Additional information may include information regarding an artist for a particular CD, or an actor from a particular movie. (Grooters, column 1, lines 51-54) For example, if a user watches a movie for a second time, the system in Grooters is capable of adding updated content to the sub-sub-channels which was not available when the movie was originally viewed, as the system has been programmed to search the Internet for updated information, and to check to see if the web sites found during the original viewing of the program are
15 still viable. (Grooters, column 8, lines 59-65)

 Searching the Internet for content information for media, as described above, is not the same or equivalent to searching the Internet for information related to a hardware device that has just been attached to a host system, as claimed in the present invention. As these steps are different, one cannot be substituted for the other.
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 Furthermore, Applicant respectfully submits that there is no motivation for one of ordinary skill in the art to combine the teaching of Kanojia with that of Grooters. In order to establish a proper prima facie case of obviousness, there must be some motivation, suggestion or

teaching of the desirability of making the specific combination that was made by Applicant. The motivation, suggestion or teaching, may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or in some cases, the nature of the problem to be solved. See *In re Dembiczak*, 50 USPQ 2d 1614 (Fed. Cir. 1999). There must be some reason, suggestion or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge cannot come from Applicants' invention itself. See *In re Oetiker*, 24 USPQ 2d 1443, 1446 (Fed. Cir. 1992). See *Dembiczak* 50 USPQ 2d. 1617.

The Office Action's motivation for combining the steps is that "it provides a method to generate information for specific devices in the system (col. 1, lines 57-67)." (Office Action, page 4) This is merely a statement of the invention in Grooters and not a motivation to combine the invention in Kanojia with that of Grooters. Furthermore, column 1, lines 57-67 of Grooters actually states that "it would be advantageous to provide an apparatus and method for automatically generating content channels based upon the audiovisual media being delivered on a particular device of a local network system" and "automatically generating channels relating to the specific devices connected to a local network system." Again this is merely a statement or summary of the invention and not a motivation to combine the invention in Kanojia with that of Grooters.

Furthermore, as Kanojia is directed toward a method and system for embedded network device installation while Grooters is directed toward an apparatus and method for automatically generating content channels associated with audiovisual media delivered on devices of a local network system, it would not have been obvious to one of ordinary skill in the art to combine their teachings as "a communication and management system that dynamically targets network devices for content deployment, such as application programs, device drivers, configuration files,

and registry subhives” (Kanojia, paragraph 0010) is not analogous to “an apparatus and system for automatically generating content channels associated with audiovisual media delivered on devices of a local network system” (Grooters, column 2, lines 1-7)

5 The motivation, suggestion or teaching to combine references, may come explicitly from statements in the prior art, the knowledge of one of ordinary skill in the art, or in some cases, the nature of the problem to be solved. The Office Action’s reasoning does not come from any of these.

Based on the foregoing reasons, Applicant respectfully submits that independent claim 25 is patentably distinguishable over Kanojia and Grooters, either alone or in combination. Therefore, Applicant respectfully requests allowance of independent claim 25.

Claims 26-27, 30 and 34-35 depend from claim 25, and are thus patentably distinguishable over Kanojia and Grooters, either alone or in combination, for at least the same reasons given above with respect to Claim 25. Therefore, Applicant respectfully requests allowance of Claims 26-27, 30 and 34-35.

15 Claim 37 is patentably distinguishable over Kanojia and Grooters, either alone or in combination for at least the same reasons given above with respect to Claim 25. Therefore, Applicant respectfully requests allowance of Claim 37.

Claims 38-39 and 41-43 depend from claim 37, and are thus patentably distinguished over Kanojia and Grooters. Therefore, Applicant respectfully requests allowance of Claims 38-39, and 41-43.

Claims 36 and 44 depend from Claims 25 and 37, respectively, and are thus patentably distinguishable over Kanojia, Grooters and Chatani. Chatani does not add to the deficiencies of Kanojia and Grooters. Therefore, Applicant respectfully requests allowance of Claim 36 and 44.

CONCLUSION

For the foregoing reasons, Applicant believes Claims 25-27, 30, 34-39, 41-44 are allowable, and a notice of allowance is respectfully requested. If the Examiner believes that a telephone conference with Applicant's representative might expedite prosecution of the application,
5 he is cordially invited to call at the undersigned attorney.

Respectfully submitted,

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